GP 2607

DOCKET: STR30100 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR:	Burroughs et al.	PRIOR EXAMINER:	K. Wieder
SERIAL NO.:	Continuation of Reissue Application Serial No. 07/963,915	PRIOR ART UNIT:	2607
FILING DATE:		DATE:	June 23, 1999
FOR:	BATTERY WITH STRENGTH INDICATOR		

PETITION TO THE COMMISSIONER FOR EXPEDITED DECISION TO ISSUE CONTINUATION REISSUE APPLICATION

Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

Applicants respectfully petition the Commissioner of Patents for an expedited decision ordering the separate and prompt issuance of a continuation reissue patent under MPEP §1451, 37 CFR §§1.177 and 1.644(a)(2), 35 USC §251, and the decision of the Federal Circuit in In re Graff, 111 F.3d 874, 42 USPQ2d 1471 (Fed. Cir. 1997).

Statement of Facts

1. This application is a continuation of parent reissue application Serial No. 07/963,915, currently pending, for reissue of U. S. Patent No. 5,015,544.

2. Pursuant to 35 USC §251 and In re Graff, a continuation of a pending reissue application may be permitted to issue.

3. The parent reissue application is involved in Interference No. 103,036.

4. Claims 13-51 of the parent reissue application were designated as corresponding to the count in the redeclaration of the interference dated August 19, 1994, (Paper No. 17).

5. In the parent reissue application, claims 12 and 52-63 were deemed not to be corresponding to the count and are not at issue in the interference.

6. In the parent reissue application, claims 12 and 52-63 are not independent and distinct from the remaining claims.

7. In the parent reissue application, all claims 1-63 were found to be allowable as stated in the Interference Initial Memorandum (Form PTO-850) dated April 15, 1994.

8. The Preliminary Amendment filed with the instant continuation reissue application cancels claims 1-11 and 13-50, and adds claims 51-62.

9. The term of the continuation reissue is not to exceed the term of U. S. Patent No. 5,015,544 which expires on February 8, 2009, twenty years from the filing date of February 8, 1989.

10. Remaining claims 12 and 51-62 are identical to claims 12 and 52-63, respectively, of the parent reissue application, are allowable and should issue as a continuation reissue patent.

REMARKS

This petition requests the immediate issuance, in a continuation reissue patent, of claims which have been designated as not corresponding to the count of an interference involving the parent reissued application. The parent of the instant continuation reissue application, No. 07/963,915, has been involved in Interference 103,036 with applicants as the senior party since the interference was re-declared in 1994 as a four-party interference involving Cataldi et al. (assignee - Eastman Kodak Co.), Tucholski (assignee - Eveready Battery Co., Inc.) and Wang et al. (assignee - Duracell International, Inc.). At that time, claims 12 and 52-63 of the parent reissue were designated as not corresponding to the count.

A decision on the first final hearing by the Board of Patent Appeals and Interferences ("the Board"), dated December 11, 1997, removed junior parties Cataldi et al. and Tucholski since they could not overcome Burroughs et al.'s filing date of February 8, 1989, of the Burroughs et al. U.S. Patent No. 5,015,544. Both Cataldi et al. (Eastman Kodak Co.) and Tucholski (Eveready Battery Co.) have appealed to the U.S. District Court for the District of Columbia under 35 USC § 146.

In the interference, a second final hearing was held on April 23, 1999, to determine priority of invention between applicants (Senior Party Burroughs et al.) and Junior Party Wang et al. The party Wang et al. had originally filed its preliminary motion no. 2 (Paper No. 135) to designate claims 1, 3, 4, 7, 8, 12, 52, 54, 56, 57, 59, 61 and 62 of the parent reissue application as corresponding to the count of the interference. This issue was not decided by the APJ or the Board prior to the second final hearing, and Wang et al. did not raise this issue in its brief for the second final hearing. As such, this issue is not entitled to further consideration and is now moot pursuant to 37 CFR § 1.640(b).

On June 18, 1999, the Board awarded priority of invention to applicants, Burroughs et al. As it is likely that this decision will be appealed and merged with the appeal from the first final hearing, applicants respectfully request that the claims of the parent reissue application which do not correspond to the count, namely claims 12 and 52-63, be issued as soon as possible as a continuation of the present reissue application in interference.

Good cause for separate and prompt issuance of this continuation reissue application is shown in that Wang et al.'s assignee, Duracell International, Inc. ("Duracell"), has a commercial product in the marketplace which infringes some of the remaining claims in the instant continuation reissue application. An enclosed Petition

to Make Special based on actual infringement is filed on even date herewith to advance prosecution of the continuation. Applicants would be severely prejudiced by the expected appeal delay of many years since the term of the reissued patent would be limited to a term expiring on February 8, 2009. Waiting until the resolution of appeals to the U. S. District Court for the District of Columbia, followed by the U. S. Court of Appeals for the Federal Circuit and the U. S. Supreme Court, would effectively leave applicants with little or no patent term.

The enclosed Preliminary Amendment introduces only the claims that have been previously determined to be allowable in the parent reissue application, and cancels all claims which correspond to the count. Examiner Wieder had previously determined in the parent reissue application that all the claims have met the requirements of 35 USC §§112 and 103 in an office action dated November 29, 1993. The Preliminary Amendment filed with the instant continuation reissue application cancels claims 1-11 and 13-50, and adds claims 51-62. New claims 51-62 in the continuation reissue are identical to claims 52-63, respectively, of the parent reissue application. Thus, claims 12 and 51-62 present allowable subject matter for which there is no issue of priority with the party Wang et al. and should issue immediately as a separate continuation of the parent reissue application.

As recognized in In re Graff, *supra*, 35 USC "§251[2] places no greater burden on [a] continuation reissue application than upon a continuation of an original application ...." 42 USPQ2d at 1473. Given the allowability of the claims, absence of any priority issues, and the good cause shown by the ongoing infringement, applicants submit that the instant continuation reissue application should be promptly issued, prior to the parent reissue application.

Applicants enclose the fee of $130.00 for this petition. Please charge any over/under payment to deposit account 04-0566. A duplicate copy of this paper is enclosed.

Respectfully submitted,

Peter W. Peterson
Reg. No. 31,867

DeLIO & PETERSON, LLC
121 Whitney Avenue
New Haven, CT 06510-1241
(203) 787-0595

CERTIFICATION OF MAILING UNDER 37 CFR 1.10

"Express Mail" mailing label number EL091883983US Date of Deposit: 6/23/99 I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents and Trademarks, Washington, D.C. 20231

Name: Kara Laudano Signature: _____

1795

DOCKET: STR30100 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR:	Burroughs et al.	EXAMINER:	
SERIAL NO.:	09/338,115	ART UNIT:	
FILING DATE:	June 23, 1999	DATE:	August 6, 1999
FOR:	BATTERY WITH STRENGTH INDICATOR		

SUPPLEMENT TO PETITION TO THE COMMISSIONER FOR EXPEDITED DECISION TO ISSUE CONTINUATION REISSUE APPLICATION

Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

As a supplement to the Petition to the Commissioner For The Expedited Decision To Issue Continuation Reissue Application filed June 23, 1999, applicants respectfully bring to the attention of the Commissioner of Patents the view under MPEP §2315.01.

REMARKS

The petition filed on June 23, 1999, requests the immediate issuance, in a continuation reissue patent, of claims which have been designated as not corresponding to the count of an interference involving the parent reissued application. Applicants find themselves in the untenable position that although the parent reissue application, which is involved in Interference 103,036, has been found by the Board of Patent Appeals & Interferences ("the Board") to have priority of invention, the pending appeals in the D.C. District Court may take several years. Applicants would then be left with an insignificant remaining patent term when the parent reissue application is finally returned to *ex parte* prosecution of the non-involved claims.

Applicants respectfully call to the attention of the Commissioner the first paragraph of MPEP §2315.01 which provides:

> Where one of several applications of the same inventor or assignee which contain overlapping claims gets into an interference, the prosecution of all cases not in the interference should be carried as far as possible .... (Emphasis added.)

It is evident that the Patent Office encourages the issuance of a continuation reissue application, notwithstanding an ongoing interference, so long as the claims do not correspond to the count. The instant continuation application falls fully within the purview of §2315.01. Once the preliminary amendment is entered, by definition the Burroughs continuation application is "not in the interference" and prosecution should be carried forward to issuance of a continuation reissue application to applicants.

Applicants respectfully request an expedited decision to the petition in light of the foregoing remarks. If any additional fees are required under 37 CFR §1.17(i) for this supplement, please charge any over/under payment to deposit account 04-0566. A duplicate copy of this paper is enclosed.

Respectfully submitted,

Peter W. Peterson
Reg. No. 31,867

DeLIO & PETERSON, LLC
121 Whitney Avenue
New Haven, CT 06510-1241
(203) 787-0595

DOCKET: STR 20100A PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR:	Burroughs et al.	PRIOR EXAMINER:	K. Wieder
SERIAL NO.:	Continuation of Reissue Application Serial No. 07/963,915	ART UNIT:	2607
FILING DATE:		DATE:	June 23, 1999
FOR:	BATTERY WITH STRENGTH INDICATOR		

PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT

Assistant Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

Pursuant to 37 CFR §1.102(d) and MPEP § 708.2, Applicants hereby petition the Commissioner to make the subject application special because of actual infringement.

Enclosed are:

1. A statement by the undersigned attorney in compliance with MPEP §708.02.II alleging that there is an infringing device actually on the market and a rigid comparison of the alleged infringing device with the claims of the application has been made; and

2. A check in payment of the petition fee required under 37 CFR §1.17(i).

Due to the fact that Applicants' claims are being infringed and Applicants require a patent in order to terminate such infringement, this Petition to Make Special is being filed.

Applicants respectfully request that this Petition be granted.

Respectfully submitted,

Peter W. Peterson
Reg. No. 31,867

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DeLIO & PETERSON, LLC
121 Whitney Avenue
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Name: Kara Laudano Signature:

DOCKET: STR 30100 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR:	Burroughs et al.	PRIOR EXAMINER:	K. Wieder
SERIAL NO.:	Continuation of Reissue Serial No. 07/963,915	PRIOR ART UNIT:	2607
FILING DATE:		DATE:	June 23, 1999
FOR:	BATTERY WITH STRENGTH INDICATOR		

STATEMENT IN SUPPORT OF PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT (MPEP §708.02.II)

I, Peter W. Peterson, state as follows:

1. I am attorney of record in the above indicated application.
2. I have made a rigid comparison of the claims in the above indicated application with the *PowerCheck*™ battery manufactured and sold by Duracell International, Inc.
3. It is my opinion that at least some of claims 12 and 51-62 in the instant application are unquestionably infringed by the manufacture, use, and sale of the *PowerCheck*™ battery.
4. I believe that I have a good knowledge of the prior art and as a result of reviewing this application and the prior art, I believe that claims 12 and 51-62, in the instant application are allowable.

Respectfully submitted,

Peter W. Peterson, Esq.
Registration No. 31,867
DELIO & PETERSON, LLC
121 Whitney Avenue
New Haven, CT 06510

CERTIFICATION OF MAILING UNDER 37 CFR 1.10

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Name: Kara Laudano Signature: Kara Laudano

DOCKET: STR30100 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR:	Burroughs et al.	PRIOR EXAMINER:	K. Wieder
SERIAL NO.:	Continuation of Reissue Application Serial No. 07/963,915	PRIOR ART UNIT:	2607
FILING DATE:		DATE:	June 21, 1999
FOR:	BATTERY WITH STRENGTH INDICATOR		

OFFER TO SURRENDER

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

The undersigned Assignee of the accompanying Continuation Reissue Application of letters patent for BATTERY STRENGTH INDICATOR, U.S. Patent No. 5,015,544, granted on May 14, 1991, hereby offers to surrender said letters patent.

Filed herewith is an order for a Title Report as required in such applications.

Respectfully submitted,

Date: 6/21/99

Alan N. O'Kain
Member
Strategic Electronics, LLC

CERTIFICATION OF MAILING UNDER 37 CFR 1.10

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Name: Kara Laudano Signature:

DOCKET: STR30100 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR:	Burroughs et al.	PRIOR EXAMINER:	K. Wieder
SERIAL NO.:	Continuation of Reissue Application Serial No. 07/963,915	PRIOR ART UNIT:	2607
FILING DATE:		DATE:	June 23, 1999
FOR:	BATTERY WITH STRENGTH INDICATOR		

REQUEST FOR ABSTRACT OF TITLE

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

Please have a duly certified Abstract of Title of United States Patent No. 5,015,544, issued May 14, 1991, to Strategic Energy Ltd., as Assignee of James R. Burroughs and Alan N. O'Kain, (Reel 5089, Frame 0106), assigned on June 5, 1995, to Strategic Electronics, LLC (Reel 7511, Frame 0498), prepared and placed in the official file of the above-identified Continuation Application for Reissue of said patent.

The fee of $25.00 is enclosed. Please charge any over/under payment to Deposit Account No. 04-0566.

Respectfully submitted,

Date: June 23, 1999

Peter W. Peterson
Reg. No. 31, 867
DELIO & PETERSON, LLC
121 Whitney Avenue
New Haven, CT 06510
(203) 787-0595

CERTIFICATION OF MAILING UNDER 37 CFR 1.10

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Name: Kara Laudano Signature:

DOCKET: STR 20100 PATENT
Reissue of U.S. Patent No. 5,015,544, issued May 14, 1991

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR:	Burroughs et al.	EXAMINER:	K. Wieder
SERIAL NO.:	963,915	ART UNIT:	2607
FILING DATE:	October 20, 1992	DATE:	January 11, 1994
FOR:	BATTERY WITH STRENGTH INDICATOR		

SECOND SUPPLEMENTAL REISSUE DECLARATION

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

Applicants James R. Burroughs, residing at 4697 White Oak Avenue, Encino, California 91316, and Alan N. O'Kain, residing at 718 Malabar Drive, Corona del Mar, California 92625, both citizens of the United States of America, declare that:

1. We previously submitted declarations in connection with the above referenced reissue application of our '544 patent, including our Reissue Declaration and Power of Attorney executed by us on October 13, 1992, and our Supplemental Reissue Declaration executed by us on May 7, 1993 and May 10, 1993. We hereby incorporate herein our statements in those declarations.

2. We believe that we are the original, first and joint inventors of the subject matter described and claimed in our '544 patent granted on May 14, 1991 and in the specification and claims of this reissue application as filed on October 20, 1992, and in the claim amendments as filed on May 11, 1993 and September 27, 1993.

3. We do not know and do not believe that the invention was ever known or used in the United States before our invention thereof.

4. We hereby state that we have received and understand the contents of the specification and claims of this reissue application as filed on October 20, 1992, and of the claim amendments as filed on May 11, 1993 and September 27, 1993.

5. We acknowledge our duty to disclose information which is material to the examination of this application in accordance with §1.56(a) of Title 37, Code of Federal Regulations.

6. We believe our original '544 patent to be partly or wholly inoperative because of error, without deceptive intent on the part of the applicants, by reason of claiming less than we had a right to claim in the patent. We believe that certain features of original claims 1-11, as more fully explained below, are not essential for practicing the broad inventive concept of our '544 patent and that new claims 12-63, as amended, correct the error of our '544 patent by claiming the invention in scope corresponding to the broad disclosure of our invention in the '544 patent. Specifically, claims 1-11 as issued in our patent are limited to a battery having a battery strength indicator and switch means in which the battery indicator means is defined as a first chamber having indicator means therein formed between top and base nonconductive layers, the switch means is defined as a deformable second chamber formed between the top and base layers, and including first, second and third conductive means.

7. We initially became concerned that we may have erred by claiming less than we had a right to claim in our '544 patent after becoming aware in late 1991 of U.S. Patent No. 5,059,895 issued October 22, 1991 to Cataldi et al., and more fully appreciated this error in 1992 after engaging in licensing negotiations with major battery manufacturers and being made aware of an Eveready Battery Company's European patent application directed to a similar invention published in July of 1992 and the application for reissue of the Cataldi et al. patent filed in September of 1992. We believe the errors which rendered our '544 patent partly or wholly inoperative, as

set forth in our original reissue application filed October 20, 1992 and in the claim amendments filed on May 11, 1993 and September 27, 1993, arose from inadvertence, accident or mistake, without deceptive intent, because of our failure to communicate more clearly to our previous attorneys, who prepared, filed and prosecuted our application, the broad scope of our invention of a battery with strength indicator so as to have our invention claimed as broadly as it was disclosed in our '544 patent specification and drawings and as broadly as we intended to have it claimed in the patent; we believe that error also arose because of our inadequate understanding of the limited scope of the claims, since we are not familiar with patent law, as set forth in paragraph 15 of our reissue declaration dated October 13, 1992.

8. With respect to the claim amendments filed on May 11, 1993, and specifically new claim 51 therein, we became concerned after October 13, 1992, the date of our original reissue declaration, and upon further review of our reissue application, that our battery strength or voltage indicator as previously broadly conceived by us and disclosed in our '544 patent was not claimed in its broadest aspect and did not require the specific recitation in the claims of a battery strength indicator and switch means in which the battery indicator means is defined as a first chamber having indicator means therein formed between top and base nonconductive layers, the switch means is defined as a deformable second chamber formed between the top and base layers, and including first, second and third conductive means, nor did it require the recitation of coupling means as recited in reissue claim 50 or thermal insulating or insulation means as recited in reissue claims 33-40 and 43-49. After consultation with our present attorney, Peter Peterson, and discussion with him concerning the breadth of disclosure of our invention, we explained to Mr. Peterson that our broad invention as disclosed in the '544 patent required only the recitation of means to transfer sufficient heat generated by the conductive layer to the temperature

sensitive color indicator material to change the color thereof and indicate voltage when the voltage indicator is in contact with a battery housing. We then added claim 51 to protect this aspect of our invention, which is broader than original claims 1-11 because it does not recite the specific construction of the battery indicator means as comprising indicating means in a first chamber between top and base nonconductive layers, switch means as comprising a deformable second chamber formed between top and base nonconductive layers, and spaced apart conductive means within the switch chamber which may be brought into contact by pressing the chamber. After the Office Action dated July 19, 1993, we also became aware of minor spelling errors of the words "in" and "indicator" in claim 51, which we corrected in the Amendment filed September 27, 1993.

9. With respect to new claims 52 and 53 of the Amendment filed on May 11, 1993, we became concerned after review of U.S. Patent No. 5,059,895, issued October 22, 1991 to Cataldi et al., that our battery strength or voltage indicator as disclosed in our '544 patent was not claimed in its broadest aspect and did not require the recitation of the specific construction of the battery indicator means as comprising a first chamber formed between top and base nonconductive layers and indicator means disposed therein, as recited in our original patent claims 1-11. After consultation with Mr. Peterson and discussion with him concerning our broad disclosure of our invention, we explained to Mr. Peterson that our invention as disclosed in the '544 patent required only recitation of a battery strength indicator formed in a layer attached to the side of a battery which undergoes a visible change when subjected to a predetermined voltage output of the battery and a battery switch biased in an open position comprising a resilient, nonconductive layer on a side of the battery with a switch chamber disposed beneath the resilient layer, with the strength indicator and switch chamber being electrically connected with each other and the

battery terminals. After further consultation with Mr. Peterson in late 1992, we also explained to him that this aspect of our invention may specifically be applied in connection with a rechargeable dry cell battery or rechargeable batteries mounted on a package frame, as now set forth in claims 52 and 53, respectively. We then added claims 52 and 53 to protect these aspects of our invention, which are broader than original claims 1-11 because they do not recite the specific construction of the battery indicator means as comprising indicating means in a first chamber between top and base nonconductive layers. After the Office Action dated July 19, 1993, we also became aware of minor spelling errors of the words "biased" and "indicate" in claim 52, which we corrected in the Amendment filed September 27, 1993.

10. With respect to the Amendment filed September 27, 1993 containing amendments to claims 13-15, 30-32, 41 and 42, we became concerned after issuance of the Office Action dated July 19, 1993 that our invention as embodied in these claims, while being commensurate with our broad conception and disclosure of our invention in the '544 patent in not requiring a battery strength indicator defined as a first chamber having indicator means therein formed between top and base nonconductive layers, switch means defined as a deformable second chamber formed between the top and base layers, and including first, second and third conductive means, did require recitation that the claimed voltage indicator is attached to the side of a battery, and that there is further incorporated on the side of the battery an electrical switch which may be activated to place the conductive layer across the terminals of the battery to indicate the voltage of the battery. After consultation with Mr. Peterson, we then instructed him to amend these claims to reflect our invention as disclosed in the '544 patent, which claims are narrower than as-filed in this reissue patent because of the inclusion of the battery and switch, but still broader than original claims 1-11 because they do not recite the specific construction of the battery indicator

means as comprising indicating means in a first chamber between top and base nonconductive layers, switch means as comprising a deformable second chamber formed between top and base nonconductive layers, and spaced apart conductive means within the switch chamber which may be brought into contact by pressing the chamber.

11. With respect to the Amendment filed September 27, 1993 containing amendments to claims 16-24, 26 and 27, we became concerned after issuance of the Office Action dated July 19, 1993, and further during our interview with Examiner Wieder on September 9, 1993, that the broadest expression of our invention as embodied in these claims did not require the recitation of the term "nonconducting" or "to prevent conduction" in connection with the recited means under the conductive layer to permit the heat generated by the conductive layer to change the color of the temperature sensitive color indicator layer and indicate voltage when the voltage indicator is in contact with a battery housing. After consultation with Mr. Peterson, we then instructed him to amend these claims, which are broader than original claims 1-11 because they do not recite the specific construction of the battery indicator means as comprising indicating means in a first chamber between top and base nonconductive layers, switch means as comprising a deformable second chamber formed between top and base nonconductive layers, and spaced apart conductive means within the switch chamber which may be brought into contact by pressing the chamber.

12. With respect to the Amendment filed September 27, 1993 containing new claims 54-63, we became concerned after issuance of the Office Action dated July 19, 1993 that our invention, as embodied in independent claims 12 and 52 (which did not specify a particular type of battery strength indicator attached to the side of the battery), further did not require the recitation of the specific construction of the battery

indicator means as comprising a first chamber formed between top and base nonconductive layers and indicator means disposed therein, as recited in our original patent claims 1-11. After consultation with Mr. Peterson, we explained to him that our invention as disclosed in our '544 patent allowed for claiming the strength indicator structures of the various embodiments of our invention as described in our '544 patent according to the following types of claims, which we requested Mr. Peterson to add to our reissue application:

a) With regard to new dependent claims 54 and 59, the structure of the battery strength indicator was broader than that set forth in the original claims 1-11 and required only a dielectric layer, a conductive layer above or below the dielectric layer, and a temperature sensitive color indicator layer in thermal contact, with the conductive layer having sufficient heat generating capacity and means to transfer sufficient heat generated by the color indicator layer to change the color of the indicator layer. This battery strength indicator structure is broader than that set forth in claims 1-11 in that it does not require the indicating means to be disposed in a first chamber between nonconductive top and base layers.

b) With regard to new dependent claims 55 and 60, the structure of the battery strength indicator was broader than that set forth in the original claims 1-11 and required only a chemical redox composition which changes color when the voltage potential across the terminals of the battery crosses a pre-determined voltage. This battery strength indicator structure is broader than that set forth in claims 1-11 in that it does not require the indicating means to be disposed in a first chamber between nonconductive top and base layers.

c) With regard to new dependent claims 56 and 61, the structure of the battery strength indicator was broader than that set forth in the original

claims 1-11 and required only a liquid crystal composition that changes phases when the voltage potential across the terminals of the battery crosses a pre-determined voltage. This battery strength indicator structure is broader than that set forth in claims 1-11 in that it does not require the indicating means to be disposed in a first chamber between nonconductive top and base layers.

d) With regard to new dependent claims 57 and 62, the structure of the battery strength indicator was broader than that set forth in the original claims 1-11 and required only a conductive layer which has a reduced cross-sectional area in contact with a heat sensitive color indicator layer adapted to undergo a color change when the temperature of the reduced cross-sectional area of the conductive layer rises to a pre-determined temperature when the voltage potential across the terminals of the battery crosses a pre-determined voltage. This battery strength indicator structure is broader than that set forth in claims 1-11 in that it does not require the indicating means to be disposed in a first chamber between nonconductive top and base layers.

e) With regard to new dependent claims 58 and 63, the structure of the battery strength indicator was broader than that set forth in the original claims 1-11 and required only a light emitting diode that undergoes a visible change when the voltage potential across the terminals of the battery crosses a pre-determined voltage. This battery strength indicator structure is broader than that set forth in claims 1-11 in that it does not require the indicating means to be disposed in a first chamber between nonconductive top and base layers.

13. We believe that the aforementioned amendments to claims 13-24, 26, 27, 30-32, 41 and 42 and new claims 51-63 correct the error of our '544 patent as to being wholly or partially inoperative or claiming less than we had a right to claim since these claims now define our invention in broader scope, but still within the bounds of

our original disclosure, by variously eliminating the requirements of the specific battery indicator means construction and specific switch means construction as described in original claims 1-11 of our '544 patent.

14. The undersigned applicants declare further that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under §1001 of Title 18 of United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Wherefore, we hereby subscribe our names to the foregoing second supplemental reissue declaration.

12-30-93
Date

James R. Burroughs

12-29-93
Date

Alan N. O'Kain

201strd2/12:93cah

DOCKET: STR 20100 PATENT
Reissue of U.S. Patent No. 5,015,544, issued May 14, 1991

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR:	Burroughs et al.	EXAMINER:	
SERIAL NO.:	963,915	ART UNIT:	1107
FILING DATE:	October 20, 1992	DATE:	May 6, 1993
FOR:	BATTERY WITH STRENGTH INDICATOR		

SUPPLEMENTAL REISSUE DECLARATION

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

Applicants James R. Burroughs and Alan N. O'Kain, citizens of the United States of America, declare that:

1. We previously submitted a declaration in connection with the above referenced reissue application of U.S. Patent No, 5,015,544, which declaration was executed by us on October 13, 1992. We hereby incorporate the statements of that declaration herein.

2. We hereby state that we have received and understand the contents of the attached preliminary amendment and new claims 51-53 of this reissue application, and we believe that we are the original first and joint inventors of the subject matter described therein and in U.S. Letters Patent No. 5,015,544.

3. We acknowledge our duty to disclose information which is material to the examination of this application in accordance with §1.56(a) of Title 37, Code of Federal Regulations.

4. We do not know and do not believe that the invention was ever known or used in the United States before our invention thereof.

5. We specifically incorporate herein the statements in paragraphs 6-15 of our previous declaration dated October 13, 1992. Additionally, we believe that the aspect of our inventive concept is broader in scope than as set forth in original claims 1-11 of our U.S. Patent No.: 5,015,544, and requires only a recitation of the subject matter described in new claims 51-53 enclosed herewith. To protect this aspect of the inventive concept of our patent, we are incorporating new claims 51-53 in this reissue application which eliminate the specific construction of the battery switch means and battery indicator means as recited in original patent claims 1-11.

6. The undersigned applicants declare further that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under §1001 of Title 18 of United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Wherefore, we hereby subscribe our names to the foregoing supplemental reissue declaration.

5/10/93
Date

James R. Burroughs

5/7/93
Date

Alan N. O'Kain

201strrd/4:93cah

DOCKET: STR30100 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR:	Burroughs et al.	)	EXAMINER: C. Chaney
SERIAL NO.:	09/338,115	)	ART UNIT: 1745
FILING DATE:	June 23, 1999	)	DATE: Nov. 9, 1999
FOR:	BATTERY WITH STRENGTH INDICATOR	)	

SECOND SUPPLEMENT TO PETITION TO THE COMMISSIONER FOR EXPEDITED DECISION TO ISSUE CONTINUATION REISSUE APPLICATION

Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

As a supplement to the Petition to the Commissioner For The Expedited Decision To Issue Continuation Reissue Application filed June 23, 1999, and the Supplement to the petition filed on August 6, 1999, applicants respectfully bring to the attention of the Commissioner of Patents the opinion of the Board of Patent Appeals and Interferences regarding claims 12 and 52-63.

REMARKS

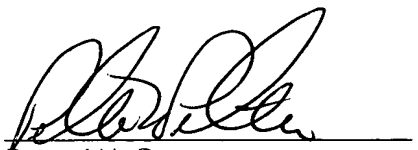
The petition filed on June 23, 1999, and the supplement to the petition filed on August 6, 1999, requests the immediate issuance, in a continuation reissue patent, of claims which have been designated as not corresponding to the count of an interference involving the parent reissue application. Applicants find themselves in the untenable position that although the parent reissue application, which is involved in Interference 103,036, has been found by the Board of Patent Appeals & Interferences ("the Board") to have priority of invention at Final Hearing, and again in the Request for Reconsideration, the pending appeals in the D.C. District Court may take several years. Applicants would then be left with an insignificant remaining patent term when

the parent reissue application is finally returned to *ex parte* prosecution of the non-involved claims.

Applicants respectfully call to the attention of the Commissioner the opinion of the Board which confirms that claims 12 and 52-63 of the instant continuation reissue application have never been designated as corresponding to the count. Furthermore, "because claims 12 and 52-63 of the reissue application are not in the interference and because no issue of correspondence of these claims to the count is before the [appeals] court for review, the claims are to a separately patentably invention and any decision on appeal as the claims which correspond to the count cannot be expected to affect their patentability."

Applicants respectfully request an expedited favorable decision to the petition in light of the foregoing remarks. If any additional fees are required under 37 CFR §1.17(i) for this supplement, please charge any over/under payment to deposit account 04-0566. A duplicate copy of this paper is enclosed.

Respectfully submitted,



Peter W. Peterson
Reg. No. 31,867

DeLIO & PETERSON, LLC
121 Whitney Avenue
New Haven, CT 06510-1241
(203) 787-0595

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR: Burroughs et al.) EXAMINER (PRIOR): K.Wieder
)
)
SERIAL NO.: Reissue Application Serial No. 09/338,115 ART UNIT (PRIOR): ~~2607~~ 1745

FILING DATE: June 23, 1999 DATE: January 14, 2000

FOR: BATTERY WITH STRENGTH INDICATOR

HAND DELIVERED

PROTEST UNDER 37 C.F.R.§1.291: OPPOSITION TO PETITION TO MAKE SPECIAL

On June 23, 1999, Applicants (assignors to Strategic Electronics LLC.) filed Reissue Application Serial No. 09/338,115[1]. Concurrently, a Petition to Make Special [37 C.F.R.1.102(d)] Because of Actual Infringement, and a Statement in support of same, were filed.

The basis of said Petition is an allegation of infringement by Duracell of claims of the subject reissue application. The submission is grounded solely upon the affidavit of Mr. Peter Peterson.

Party opponent Duracell hereby protests said Petition and urges that Strategic's submission is insufficient to justify the requested relief.

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[1]This is a continuation Reissue of Reissue Application Serial No. 07/963,915

Firstly, Duracell, through counsel, denies infringement of any enabled claim of the reissue application supported by the written description and patentable over the prior art. Secondly, Duracell denies infringement of any claim of the reissue application as properly construed and applied to the Duracell product.

Duracell manufactures and sells a battery including an on cell tester which product is identified on the record of closed Interference 103,036 as Burroughs et al. Exhibit 2.

Strategic has therefore had the access and opportunity to examine the issue of infringement. However, Mr. Peterson's statement merely provides an unsupported conclusory assertion that the Duracell product infringes "at least some" of the claims of the reissue application.

If such a subjective assertion is accepted as sufficient for expedited prosecution, there may as well be no basis required. Clearly, in these circumstances the basis for expedited prosecution must be grounded upon an objective analysis, establishing that prima facie these claims are patentable over the prior art.

Petitioner Strategic has in effect met no burden at all: the affidavit of Mr. Peterson provides no basis for a justifiable conclusion that expedited prosecution should be granted.

This application has not been examined for compliance with 35 U.S.C. 112, first and second paragraphs, 35 U.S.C. 102 and 103. Substantial issues were litigated in closed Interference 103,036 which resulted in rulings on scope and meaning of claim terms presented in these reissue claims. Those issues remain on appeal before the District Court for the District of Columbia in actions that include Strategic Electronics as a party.

At the very least, Petitioner should be required to present a prima facie case that its claims, in their present terms, are patentable under the statutory standards applicable including 35 U.S.C. 112, first and second paragraph, and 35 U.S.C. 102 and 103, in the context of the rulings in closed Interference 103,036. Then, it should be required to establish, prima facie, why the rulings now on appeal would not in any respect affect the patentability of the reissue claims.

Having failed to so proceed, even facially, Strategic's Petition rests on a thin reed indeed - the mere conclusory allegation that Duracell will infringe some or any claim, which claim is of presently unknown scope pending examination, including consideration of the statutory standards. This is conjecture, plain and simple. It is denied by Duracell. It is self-evident that at the present time no rational analysis could support such a conclusion.

Absent such a grounding for the Petition it must be denied. All reissue applications are entitled to expedition (37 C.R.R.1.176) but the Petition does not establish any basis for special treatment, especially where it is grounded solely upon an ex parte, unsupported aspersion.

Strategic's real reason for special expedition in prosecution is to end-run the appeal, and prevent the United States Patent and Trademark Office from conducting proper consideration and fact finding on patentability.

The interference is closed only for United States Patent and Trademark Office purposes; appeals from judgments at both Final Hearings in de novo proceedings are underway in the District Court for the District of Columbia. The rulings below are accordingly not conclusive.

Moreover they are not complete: Issues of correspondency of claims raised by the parties at Final Hearing I were never reached by the Board. Then, reopening of the motion period preceding Final Hearing II was erroneously denied by the APJ, notwithstanding a suggestion of a construction of the count, later confirmed, which would have formed a basis for additional motions. These issues are thus unresolved.

Finally, a reversal on appeal would make the interference count, and the claims of the opponent parties then properly found to correspond to the count as finally construed,

prior art to Strategic. Any ruling on patentability preliminary thereto would be premature.

For all of the foregoing reasons, undue dispatch is not seen to be justified in the circumstances of this application.

A Certificate of Service of this Protest under 37 C.F.R. 1.248 is attached.

Respectfully submitted,

Dated: January 14, 2000

Richard L. Catania
Reg. No. 32,608
Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343

CERTIFICATE OF SERVICE UNDER 37 C.F.R. 1.248

I hereby certify that a true copy of the attached PROTEST UNDER 37 C.F.R. 1.291: OPPOSITION TO PETITION TO MAKE SPECIAL was served by deposit, postage pre-paid, with the UNITED STATES POSTAL SERVICE, First Class mail, in an envelope addressed to the following counsel of record, and by facsimile, on January 14, 2000

Peter W. Peterson, Esq.
Delio & Peterson
121 Whitney Avenue
New Haven, CT 06510-1241

Facsimile: (203)787-5818

Dated: January 14, 2000

Richard L. Catania

wk\f:\work\848\FS1819\opposition\FS1819.opi0

TOTAL P.07

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 875

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

CHI-CHUNG WANG,
TERRY C. EISENSMITH,
CHARLES E. KIERNAN
and ROBERT L. MILANESE
Junior Party [1]

v.

JAMES R. BURROUGHS (REISSUE)
and ALAN N. O'KAIN
Senior Party[2]

JAMES R. BURROUGHS (PATENT)
and ALAN N. O'KAIN
Senior Party[3]

Interference No. 103,036

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[1] Application 07/730,712, filed July 16, 1991. Assignor to Duracell International Inc.

[2] Reissue Application 07/963,915, filed October 20, 1992. Accorded Benefit of U.S. Application No. 07/308,210, filed February 8, 1989, now U.S. Patent No. 5,015,544, issued May 14, 1991. Assignors to Strategic Energy Ltd.

[3] Application 07/308,210, filed February 8, 1989, now U.S. Patent No. 5,015,544, issued May 14, 1991. Assignors to Strategic Energy, Ltd.

Before URYNOWICZ, METZ and HANLON, Administrative Patent Judges.

URYNOWICZ, Administrative Patent Judge.

Decision on Preliminary Motion

Wang et al. (Wang) has filed a paper titled PETITION UNDER 37 C.F.R. §1.654(d) FOR LEAVE TO FILE AND FOR CONSIDERATION OF BELATED WANG ET AL. MOTION NO. 29 FOR ENTRY OF JUDGMENT ADVERSE TO BURROUGHS, ET AL. UNDER 37 C.F.R. §1.635 and §1.662(b) (Paper No. 874). Wang's motion no. 29 for judgment is titled THE PARTY WANG ET AL'S BELATED MOTION NO. 29 FOR ENTRY OF JUDGMENT ADVERSE TO BURROUGHS, ET AL. UNDER 37 C.F.R. §1.635 AND §1.622(b) (Paper No. 868).

The party Burroughs et al. (Burroughs) has filed a combined opposition to the petition and belated motion. (Paper No. 872).

Wang has filed a reply to the combined opposition (Paper No. 873).

Wang's petition is in effect a miscellaneous motion under 37 C.F.R. § 1.635 to show good cause under 37 C.F.R. § 1.645(b) why the belated preliminary motion for judgment was not timely filed, and it is treated as such. Although this paper does not include the certification required under 37 C.F.R. § 1.637(b), the belated motion for judgment itself includes such a certification and it is considered that Wang has in effect complied with Rule 637(b).

As noted by Wang, its belated motion could not have been filed sooner because the Burroughs continuation reissue application which is the basis for the motion was not filed in the U.S. Patent and Trademark Office until June 23, 1999. Accordingly, Wang has establish good cause why the motion was not timely filed during the period set for filing preliminary motions.

Wang's Position

Wang's statement of the reasons why its preliminary motion for judgment against Burroughs should be granted is to the following effect.

Rule 662(b) is applicable to protect parties engaged in the appellate process, whereby rulings of the board may be reversed or modified. Involved in pending appeals already filed in this case by the parties Tucholski and Cataldi et al. are "issues of construction of the Count, written description support in the Burroughs, et al. specification, and patentability", and each of these issues may impact directly upon the patentability to Burroughs of the claims in its continuation reissue application.

Rule 662(b) exists to prevent an interference party such as Burroughs from accomplishing an end-run around the proceeding by filing a reissue application, and prosecuting issues related to the interference in another forum. The rule is intended to prevent inconsistency in position. If Burroughs' basis for filing a continuation reissue is abandonment of the patent claims, then the result should be adverse judgment in the interference under Rule 662(b). If Burroughs' purpose is to circumvent inter partes prosecution and avoid the pendency of the appeals, the result should be a sanction of adverse judgment.

Opinion

We are of the opinion that the motion should be denied essentially for the reasons set forth by Burroughs in its opposition.

Burroughs continuation reissue application was filed with claims 1-50, identical to those of the involved Burroughs reissue application. The continuation reissue application was accompanied by a preliminary amendment which requested the cancellation of claims 1-11 and 13-50, and the addition of claims 51-62. The remaining continuation reissue application claims 12 and 51-62 are identical to claims 12 and 52-63, respectively, of the parent involved reissue application.

First of all, even assuming that issues in the appeals filed in court may impact directly upon the patentability to Burroughs of its continuation reissue claims 12 and 51-62, Wang has not established that judgment under Rule 662(b) should be entered against Burroughs in this proceeding for that reason. At most, such a situation might be cause for the Commissioner to delay issuance of a patent to Burroughs based on its continuation reissue application. The board has no jurisdiction over the continuation reissue application because it is not in this interference, and cannot delay its issuance even if it had authority to do so and thought that to be a proper course of action.

Furthermore, even assuming the board has authority to delay issuance of the Burroughs continuation reissue application, Wang has not established that issues in the appeals could impact upon the patentability to Burroughs of its continuation reissue claims, such that issuance of the

continuation reissue should be delayed. Burroughs reissue claims 12 and 52-63 have never been designated as corresponding to the count. None of the parties raised the issue at final hearing that reissue claims 12 and 52-63 should be designated as corresponding to the count. Although Wang filed its preliminary motion no. 8 (Paper No. 135) which sought to have reissue claims 1, 3, 4, 7, 8, 12, 52, 54, 56, 57, 59, 61 and 62 designated as corresponding to the count, this motion was not acted upon by the Administrative Patent Judge in a decision on preliminary motions. When the interference came to final hearing, Wang failed to raise this matter in its brief. Thus, because claims 12 and 52-63 of the reissue application are not in the interference and because no issue of correspondence of these claims to the count is before the court for review, the claims are to a separately patentable invention and any decision on appeal as to claims which correspond to the count cannot be expected to affect their patentability.

The Monsanto v. Kamp[4] and Celanese v. Brenner[5] cases cited by Wang in its petition are not controlling and do not require that issuance of the continuation reissue be delayed by the U.S. Patent and Trademark Office until the appeals are decided. Both cases involved attempts by applicants that had received favorable priority decisions from the board to have patents issue on their involved applications prior to the conclusion of appeals by the losing patentees. That is not

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[4] 360 F.2d 499, 146 USPQ 431 (D.C. Cir. 1965)
[5] 409 F.2d 430, 159 USPQ 712 (D.C. Cir. 1968)

the situation here. Burroughs' continuation reissue application is not involved in this interference and, when issued, would have no claims corresponding to the count of the interference which might become unpatentable to Burroughs based on a decision on appeal against Burroughs.

Burroughs has not abandoned its patent claims by filing its continuation reissue application nor has it been shown that Burroughs sought to circumvent inter partes prosecution. The patent claims are pending in the involved parent reissue application of Burroughs and are not abandoned by it. Thus, Rule 662(b) does not apply against Burroughs based on these facts. Burroughs has not sought to circumvent inter partes prosecution by filing its continuation reissue application because its corresponding claims are in its parent reissue application, and no claim which corresponds to the count is in its continuation reissue application. The Burroughs reissue application was involved in the judgment of this proceeding and will be involved in any decision on appeal to court. The continuation reissue application does not claim the same invention as defined by the count, and that application has not been established as an instrument by which Burroughs is attempting to circumvent a final decision in this proceeding as to all the parties.

The motion is denied.

STANLEY M. URYNOWICZ, JR.
Administrative Patent Judge

ANDREW H. METZ
Administrative Patent Judge

ADRIENE LEPIANE HANLON
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

SMU/dal

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